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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			EXAMINER NGUYEN, KEVIN M	
			ART UNIT	PAPER NUMBER
			2674	

DATE MAILED: 01/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/819,920	<b>Applicant(s)</b> KOMATSU, YOSHIKI	
	<b>Examiner</b> Kevin M. Nguyen	<b>Art Unit</b> 2674	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10, 13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 13 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### ***Request for Continued Examination***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/28/2005 has been entered. An action on the RCE follows:
2. This office action is made in response to applicant's amendment/argument filed on 10/20/2005. Claims 11 and 12 are cancelled, and claims 1 and 8 are amended. Thus, claims 1-10, 13 and 14 are currently pending in the application. Applicant's arguments, see pages 7-11, with respect to amended claims 1 and 8 are moot in view of the new ground(s) of rejection.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-10, 13 and 14 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,756,972. Although the conflicting claims are not identical, they are not patentably distinct from each other because current application claims 1 and 8 recite at least one limitation "wherein the written information inputting device further includes an erase designating portion for erasing the written information by designating the certain position in the input area, and a sound data erasing device that erases the sound data from the sound data storage device if all of the written information is erased from the input area", whereas the patentable claims 1 and 13 of U.S. Patent No. 6,756,972 recite at least one limitation "an erasing unit that performs an erasing operation to erase the coordinate data stored in the temporary storage device, wherein the coordinate controller of each of the coordinate input devices transmits the coordinate data stored in the temporary storage device to the display device, through the transmitter, when the images manually input from the coordinate data input devices are entirely erased by the erasing unit". Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to recognize that said at least limitation of the current application are broader than said at least limitation of U.S. Patent No. 6,756,972, and performs the same functionality for erasing the sound data from the sound data storage device if all of the written information is erased from the touch-sensitive input screen.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 8, 9, 13 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Atwood et al (US 6,353,193) hereinafter Atwood.

7. It is respectfully submitted that in the case law stated “Drawing as a Reference”, “Things clearly shown in reference patent drawing qualify as prior art features, even though unexplained by the specification”. See *In re Mraz*, 173 USPQ 25 (CCPA 1972). “A claimed invention may be anticipated or rendered obvious by a drawing in a reference, whether the drawing disclosure by accidental or intentional. However, a drawing is only available as a reference for what it would teach one skilled in the art who did not have the benefit of applicant’s disclosure”. See *In re Meng*, 181 USPQ 94, 97 (CCPA 1974). “Absent of any written description in the reference specification of quantitative values, arguments based on measurement of a drawing are of little value in proving anticipation of a particular length”. See *In re Wright*, 193 USPQ 332, 335 (CCPA 1977).

8. As to claim 1, Atwood teaches an information recording and reproducing apparatus (see Fig. 1), comprising:

a recording mode [a draw mode 206/writing mode, see col. 6, lines 50-54]  
selecting device that includes a recording position designating portion for designating a

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certain position in an input area [the designate portion/the certain area corresponding to function touch keys designate for red, blue, black, and green 22-28, see Fig. 1]; and

a recording switch [whether the mode selected is the recording mode or erase mode, see Fig. 13, col. 10, lines 34-35] that outputs a recording start signal and a recording end signal [the pre-established maximum allowable distance for the draw sound mode has been set, see col. 10, lines 44-45] of sound data in response to a switching of the switch [the distance sound data includes the start point and the end point];

a coordinate on data detecting device [a digitizer 12 is x and y coordinates input data, see fig. 1, col. 11, lines 6-7] that detects coordinate data of a position in the input area designated by the position designating portion [the digitizer 14 includes the designate portion/the certain area corresponding to the function touch keys 22-28, see Fig. 1];

a designated coordinate data storing device that stores the coordinate data detected by the coordinate data detecting device as designated coordinate data [writing modes include the selection of pen color to be recorded in memory 52, see Fig. 1, col. 6, lines 51-53];

a written information inputting device that includes an input position designating portion for inputting written information by designating the certain position in the input area [the digitizer 12 includes writing surface 14 on which the user can write information including alphanumerical characters as shown at 16 and/or graphical illustration useful, see col. 5, lines 48-52],

wherein the coordinate data detecting device detects coordinate data of a position designated by the position designating portion of the written information inputting device [the digitizer 12 includes x and y coordinates input data, see fig. 1, col. 11, lines 6-7; the digitizer 14 includes the designate portion/the certain area corresponding to the function touch keys 22-28, see Fig. 1],

wherein the written information inputting device further includes an erase designating portion for erasing the written information by designating the certain position in the input area [an eraser function 30, and a narrow erase function area 32, see Fig. 1, col. 6, lines 58-67];

a sound data storing device that starts recording the sound data in association with the designated coordinate data in response to an output of the recording start signal and that ends recording in response to an output of the recording end signal [a draw sound is generated with said pre-established maximum distance, step 206 and transmitted over speakers 46, see Figs. 1 and 13, col. 10, lines 37-42];

a sound data erasing device [the eraser function 30, and the narrow erase function area 32, see Fig. 1, col. 6, lines 58-67] that erases the sound data from the sound data storage device if all of the written information is erased from the input area [the operation of the eraser function 30, and the narrow erase function area 32 is described more details in col. 6, lines 58-67, and in Fig. 13, erasing sound of step 220, see col. 10, lines 54-65].

9. Claim 8 shares the same limitations as those of claim 1 and therefore the rationale for rejection will be the same.

10. As to claim 2, Atwood teaches further comprising a written information storing device that stores the coordinate data of the written information inputting device as stroke data in association with the sound data by the designated coordinate data [If the draw mode is selected, a draw sound is generated, step 206 and transmitted over speakers 46, FIG. 1. For example, a clicking sound may be generated similar to the sound made by a cursor moving across a traditional personal computer screen to provide positive feedback that the user is indeed in the correct mode when writing on the whiteboard. The pre-established maximum allowable distance and change in velocity filter values for the draw mode are then set, step 208, FIG. 13 and processing continues, step 210 to collect and filter the writing data discussed in more detail with reference to FIG. 14. This continues for so long as some object is making contact with the writing surface, step 212 and thereafter the data is assembled, step 214 and added to storage, step 216, for example, memory 52, FIG. 1 and the display is then updated, step 218 whereupon processing resumes at step 200, see col. 10, lines 37-54].

11. Claim 9 shares the same limitations as those of claim 2 and therefore the rationale for rejection will be the same.

12. As to claims 13 and 14, Imai further teaches wherein the recording switch is disposed on the recording mode selecting device, and wherein the recording switch is disposed on the input area [When the pen is pressed down and a stroke is made, the current time and a sequence of coordinate points showing the stroke of the pen are recorded in the first table (operation A). At the same time, a linkage between the entry in the first table and the displayed location on the screen is written into the second table



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(operation C). The event inputted by the pen at this time is displayed on the screen and is sent to the displaying section 8 at the time of playback to display on the screen (operation B), see col. 6, lines 27-35]. Thus, it would have been obvious to provide the recording switch is disposed on the digitizer.

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 3-7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Atwood in view of Imai et al (US 5,818,436) hereinafter Imai.

15. As to claim 3, Atwood teaches all of the claimed limitations of claim 1, except wherein the written information storing device stores a plurality of sets of the stroke data in association with the sound data via the designated coordinate data, the apparatus further comprises: a playback mode selecting device that includes a playback position designating portion for designating a playback position in the input area and that outputs a playback start signal; and a sound data playback device that starts a playback of the sound data stored in the sound data storing device in association with one of the plurality of sets of stroke data via the designated coordinate data for a position designated by the playback position designating portion in response to an output of the

playback start signal when the designated coordinate data is determined to be included in a range of the input area where the one of the plurality of sets of stroke data belongs.

However, Imai teaches wherein the written information storing device stores a plurality of sets of the stroke data in association with the sound data via the designated coordinate data, the apparatus further comprises: a playback mode [various playback modes, see col. 9, lines 54-60] and a sound data playback device [the recorded sound data can be partially played back and this playback can be carried out while recording in the conference, and an action for this playback is also construed as one of input events in a broader sense. When playing back a desired part of the sound data, a user will specify displayed characters and figures, saying "let's consider by playing back this part", and this specified spot is entered in the first table at portion "C" in FIG. 4 by combining the time data when the spot is specified with an identifier indicating that the input is "playback", see col. 7, lines 26-35].

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to implement the playback mode and the sound data playback device as taught by Wang in the information input device of Atwood in order to achieve the benefit of playing back selectively a desired part of continuous data by using an input event as a clue (see Imai, col. 1, lines 59-60).

16. As to claim 4, Imai further teaches wherein the written information inputting device uses one end of a pen-type member as the input position designating portion, and the recording mode selecting device uses another end of the pen-type member as the recording position designating portion [the following explanation will be made

referring to a combination of a pen and sound recording, see col. 6, lines 11-19; it is possible to integrate the recording unit and the playback unit into one device, or to provide only functions necessary for recording as a recording device and only functions necessary for playback as a playback device. In short, the recording unit and the playback unit can share a medium in which the input events and the links between the input events and the time data are stored and a medium in which the continuous data are recorded, see col. 5, lines 55-62].

17. As to claim 5, Imai further teaches wherein the written information inputting device and the recording mode selecting device share one end of a pen-type member as a common position designating portion and the pen-type member is provided with a switching device that selects a function of the pen-type member between the written information inputting device and the recording mode selecting device. Claim 5 shares the same limitations as those of claim 4 and therefore the rationale for rejection will be the same. It would have been obvious to share the written information inputting device and the recording mode selecting device in a common tip of the pen.

18. As to claim 6, Imai further teaches wherein the written information inputting device and the recording mode selecting device individually use one end of respective pen-type members. Claim 6 shares similar limitations to those included in claim 5 and therefore the rationale of rejection will be the same. Claim 6 has the added limitation "as the input position designating portion and the recording position designating portion, respectively" [Figure 21 of Imai further teaches the display controlling section 9 displays a pop-up window as shown in FIG. 21. As seen in FIG. 21, the user selected mesh

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location corresponds to an entry providing a first time T1 in the first table, see col. 12, lines 50-52; A plurality of input events that correspond to the location on the screen are retrieved from the first table by following the list structure of the second table. When the user selects which point of time is to be played back via the specifying section 6, such as by "clicking a button" in the pop-up window, a part of the continuous data which corresponds to the selected input event is played back with the mechanism shown in FIG. 8(a), see col. 12, lines 59-67].

19. As to claim 7, Imai further teaches wherein the recording switch is an on-off switch that is activated by the recording position designating portion making contact with the input area [When the pen is pressed down and a stroke is made, the current time and a sequence of coordinate points showing the stroke of the pen are recorded in the first table (operation A), see col. 6, lines 27-35]. It would have been obvious to recognize that when the pen press down corresponding to the recording switch is an on; otherwise, when the pen does not press down corresponding to the recording switch is an off.

20. Claim 10 shares the same limitations as those of claim 3 and therefore the rationale for rejection will be the same.

### ***Response to Arguments***

21. Applicant's arguments with respect to claims 1-10, 13 and 14 have been considered but are moot in view of the new ground(s) of rejection.

**Conclusion**


22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M. Nguyen whose telephone number is 571-272-7697. The examiner can normally be reached on MON-THU from 8:00-6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick N. Edouard can be reached on 571-272-7603. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8000.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the Patent Application Information Retrieval system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kevin M. Nguyen  
Patent Examiner  
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January 20, 2006

  
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